

NELSON MULLINS RILEY & SCARBOROUGH LLP

LAUREN A. DEEB (SBN 234143)
lauren.deeb@nelsonmullins.com
19191 South Vermont Avenue, Suite 900
Torrance, CA 90502
Telephone: 424.221.7400
Facsimile: 424.221.7499

CRAIG N. KILLEN (*pro hac vice* to be submitted)

craig.killen@nelsonmullins.com
301 South College Street, 23rd Floor
Charlotte, North Carolina 28202
Telephone: 704.417.3127
Facsimile: 803.255.9831

Attorneys for Plaintiff
SUNENERGY1, LLC

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA – EASTERN DIVISION

SUNENERGY1, LLC,

Plaintiff,

v.

SUN ENERGY CONSTRUCTION, a
California corporation

Defendant.

Case No.:

COMPLAINT FOR:

- 1: TRADEMARK INFRINGEMENT**
- 2: FALSE DESIGNATION OF ORIGIN**
- 3: CALIFORNIA TRADEMARK INFRINGEMENT**

JURY TRIAL DEMANDED

1 Plaintiff SunEnergy1, LLC, by and through its undersigned attorneys, files
2 this Complaint against Defendant Sun Energy Construction (“Defendant”), a
3 California corporation, and hereby alleges as follows:

4 **NATURE OF THE ACTION**

5 1. Plaintiff owns exclusive trademark rights in the mark
6 “SUNENERGY1” in connection with services including, *inter alia*, construction,
7 installation, and/or maintenance of solar photovoltaic (PV) systems.

8 2. As will be explained more fully below, Defendant is using various
9 words, terms, names, symbols, devices and/or combinations thereof that are
10 confusingly similar to Plaintiff’s SUNENERGY1 mark for construction,
11 installation, and/or maintenance of solar PV systems, in clear violation of Plaintiff’s
12 rights. The Defendant is thus taking a “free ride” on the commercial success of the
13 SUNENERGY1 brand that Plaintiff has spent considerable effort and resources to
14 build.

15 3. Through this action, Plaintiff combats the infringement of its valuable
16 trademark.

17 **PARTIES**

18 4. Plaintiff SunEnergy1, LLC is a limited liability company organized
19 and existing under the laws of the State of North Carolina.

20 5. Defendant Sun Energy Construction is a corporation organized and
21 existing under the laws of the State of California and having its principal and
22 registered office at 9037 Arrow Route, Suite 100, Rancho Cucamonga, CA 91730.

23 6. Defendant operates as a solar contractor pursuant to California license
24 no. C46 1043184. Classification C-46 defines a solar contractor as follows:

25 A solar contractor installs, modifies, maintains, and repairs thermal
26 and photovoltaic solar energy systems. A licensee classified in this
27 section shall not undertake or perform building or construction
28

1 trades, crafts, or skills, except when required to install a thermal or
 2 photovoltaic solar energy system.

3 California Code of Regulations, Title 16, Division 8, Article 3.

4 **JURISDICTION AND VENUE**

5 7. This Court has subject matter jurisdiction over this case pursuant to 15
 6 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 1338(b) because claims herein
 7 arise out of federal trademark laws as codified in 15 U.S.C. § 1114 and 15 U.S.C. §
 8 1125(a) (*i.e.*, trademark infringement, false designation of origin, and unfair
 9 competition). This Court also has supplemental jurisdiction over Plaintiff's claims
 10 arising under common law or state law pursuant to 28 U.S.C. § 1367(a) because the
 11 claims are so related to Plaintiff's federal law claims that they form part of the same
 12 case or controversy and derive from a common nucleus of operative facts.

13 8. This Court has general personal jurisdiction over Defendant due to its
 14 residence and business activities in this judicial district. This Court has specific
 15 personal jurisdiction over Defendant due to the nature and quality of its actions
 16 toward the state in which this Court is located. The claims asserted herein arise out
 17 of and relate to such actions and this Court's exercise of specific personal
 18 jurisdiction over Defendant comports with traditional notions of fair play and
 19 substantial justice.

20 9. Venue in this judicial district is proper for these claims pursuant to 28
 21 U.S.C. § 1391(b). As described herein, Defendant resides in this judicial district, a
 22 substantial part of the events or omissions giving rise to these claims occurred in
 23 this judicial district, and Defendant has extensive contacts with this judicial district
 24 relating to Plaintiff's claims. Defendant conducts regular and systematic business
 25 transactions in this judicial district, including direct sales to customers in this
 26 judicial district, which violate Plaintiff's intellectual property rights.

27 **FACTUAL ALLEGATIONS COMMON TO ALL CLAIMS**

28 A. The SUNENERGY1 Trademark and Services

10. Plaintiff is the exclusive owner of United States Trademark Registration No. 4,241,915 (“the ‘915 Registration”) for the mark SUNENERGY1® for, *inter alia*, “construction, installation and maintenance of solar PV systems.” The ‘915 Registration issued November 13, 2012. The ‘915 Registration is incontestable pursuant to 15 U.S.C. § 1065. A true and correct copy of the ‘915 Registration is attached hereto as Exhibit A.

11. The filing of the application that became the ‘915 Registration constitutes constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the services specified in the registration that predates any use of the infringing marks by Defendant.

12. Plaintiff has offered and continues to offer services under the SUNENERGY1 mark since at least October 2009. The SUNENERGY1 mark is used in all the customary ways, including in advertising of the services.

13. The SUNENERGY1 mark, as well as the goodwill arising therefrom, has never been abandoned.

14. Through extensive use of the SUNENERGY1 mark, Plaintiff has spent substantial time, money, and effort in developing consumer recognition and awareness of its brand. Plaintiff has built up and developed significant customer goodwill in its business.

15. Plaintiff has engaged in business development activities in the state of California and is likely to do so in the future.

B. Use of Confusingly Similar Marks by the Defendant

16. After discovering that the Defendant was using one or more words, terms, names, symbols, devices and/or combinations thereof that are confusingly similar to Plaintiff’s SUNENERGY1 mark, Plaintiff, through counsel, sent a cease and desist letter to Defendant on December 21, 2021. The letter instructed Defendant to confirm by January 21, 2022 that *inter alia* all use of any mark that is

1 confusingly similar to Plaintiff's SUNENERGY1 mark had ceased. A copy of this
2 cease and desist letter is attached as Exhibit B.

3 17. The cease and desist letter was sent to Defendant by Fedex. According
4 to Fedex tracking information (Exhibit C), the cease and desist letter was delivered
5 on December 22, 2021.

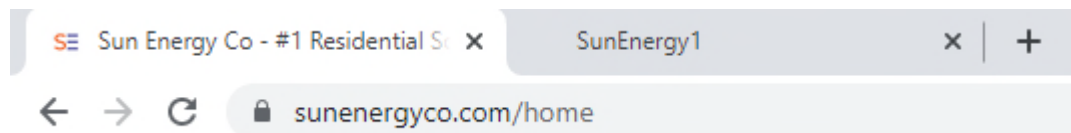
6 18. Defendant has not responded in any way to the December 21, 2021
7 cease and desist letter.

8 19. A subsequent inspection of the Defendant's website showed that
9 Defendant is still infringing Plaintiff's SUNENERGY1 mark. For example, the web
10 page <https://www.sunenergyco.com/home> (accessed March 14, 2022) prominently
11 shows the following ("Defendant Logo"):



12
13
14
15
16 The similarities are apparent. Both marks prominently feature SUNENERGY as
17 one word. The colors are essentially the same as the version of Plaintiff's mark in
18 the '915 Registration, just reversed. Both marks feature a vertical element which is
19 the number "1" or the like.

20 20. In addition, the website tab of the web page
21 <https://www.sunenergyco.com/home> (accessed March 14, 2022) uses the number
22 "1" after Sun Energy, as shown below (beside the tab of Plaintiff's home page):



23
24
25
26 The use of the number "1" in this manner, especially in light of Defendant's use of
27 the Defendant Logo, further compounds damage to the Plaintiff.
28

21. Defendant's services are closely related, if not identical, to the services offered by Plaintiff under the SUNENERGY1 mark.

22. Defendant is not authorized by Plaintiff or anyone acting on Plaintiff's behalf to sell, offer for sale, or perform services bearing the SUNENERGY1 mark, or any variations thereof.

23. Defendant uses words, terms, names, symbols, devices and/or combinations thereof confusingly similar or identical to the SUNENERGY1 mark to confuse consumers and aid in the promotion and sales of its services.

24. Defendant's actions outlined above are likely to deceive, confuse, and mislead purchasers and prospective purchasers into believing that the services are authorized by Plaintiff.

25. The likelihood of confusion, mistake, and deception brought about by Defendant's unauthorized use of the confusingly similar marks is causing irreparable harm to the goodwill symbolized by the SUNENERGY1 mark and the reputation for quality that said mark embodies.

26. Defendant's unauthorized use of confusingly similar marks began after Plaintiff legally established the existence and significant value of the SUNENERGY1 mark, including after Plaintiff's adoption and use of the SUNENERGY1 mark and after Plaintiff obtained the '915 Registration.

27. Defendant's infringing acts reflect adversely on Plaintiff, result in economic loss to Plaintiff including loss of sales of genuine services, damage the goodwill of the SUNENERGY1 brand, and thwart Plaintiff's honest efforts to promote its genuine services using the SUNENERGY1 mark.

COUNT I

TRADEMARK INFRINGEMENT – 15 U.S.C. § 1114

28. Plaintiff re-alleges and incorporates by this reference each and every allegation in paragraphs 1 through 27 as though set forth fully herein.

1 29. The SUNENERGY1 mark is prominently used in customary ways in
2 connection with authorized services, including in advertising of the services.
3 Plaintiff continues to preserve and maintain its rights with respect to the
4 SUNENERGY1 mark.

5 30. Defendant's actions to sell, offer for sale, and perform services using
6 designations that are confusingly similar to the SUNENERGY1 mark as described
7 herein are likely to cause confusion or mistake, or to deceive consumers, the public,
8 and the trade into believing that the Defendant's services are genuine or authorized
9 services of the Plaintiff.

10 31. The foregoing acts of Defendant constitute direct, contributory, and/or
11 vicarious trademark infringement in violation of 15 U.S.C. § 1114.

12 32. Plaintiff has been damaged as a result of Defendant's infringement of
13 the SUNENERGY1 mark. Plaintiff alleges, on information and belief, that
14 Defendant's sale and distribution of its services have resulted in lost sales to
15 Plaintiff, have reduced the business and profits of Plaintiff, and have injured the
16 general reputation of Plaintiff, all to Plaintiff's damage in an amount not yet
17 ascertainable, but will be determined during this action.

18 33. Plaintiff alleges, on information and belief, that Defendant has derived,
19 received, and will continue to derive and receive from the aforesaid acts of
20 infringement, gains, profits, and advantages in an amount not yet ascertainable, but
21 will be determined during this action.

22 34. Defendants acted intentionally and/or willfully in infringing upon the
23 SUNENERGY1 mark through the sale, offering for sale, and distribution of its
24 services, knowing that the SUNENERGY1 mark belonged to Plaintiff, that
25 Defendant was in fact infringing, and that Defendant was not authorized to infringe
26 upon the SUNENERGY1 mark through sale and distribution of its services.

27 35. The acts of direct, contributory, and/or vicarious trademark
28 infringement committed by Defendant has caused, and will continue to cause,

1 Plaintiff irreparable harm unless they are enjoined by this Court. On information
 2 and belief, Defendant's actions were committed in bad faith and with the intent to
 3 cause confusion and mistake, and to deceive the consuming public as to the source,
 4 sponsorship, and/or affiliation of Defendant with the Plaintiff.

5 **COUNT II**

6 **FALSE DESIGNATION OF ORIGIN – 15 U.S.C. § 1125(a)**

7 36. Plaintiff re-alleges and incorporates by this reference each and every
 8 allegation in paragraphs 1 through 35 as though set forth fully herein.

9 37. Defendant's unauthorized use of words, symbols, slogans, color
 10 schemes, images, and designs that are confusingly similar to Plaintiff's
 11 SUNENERGY1 mark constitutes a wrongful and false representation to the
 12 consuming public that the services sold by Defendant originated from Plaintiff or
 13 somehow are authorized by or affiliated with Plaintiff.

14 38. Defendant's actions as described herein constitute violation of 15
 15 U.S.C. §1125(a), as such actions are likely to cause confusion, or to cause mistake,
 16 or to deceive as to the affiliation, connection, or association of Defendant with
 17 Plaintiff and/or as to the origin, sponsorship, and/or approval of the Defendant's
 18 services by Plaintiff. These acts amount to false designations of origin.

19 39. Plaintiff has been damaged as a result of Defendant's actions described
 20 herein. Plaintiff alleges, on information and belief, that Defendant's infringing
 21 actions have resulted in lost sales to Plaintiff, have reduced the business and profits
 22 of Plaintiff, and have injured the general reputation and goodwill of Plaintiff, all to
 23 Plaintiff's damage in an amount not yet ascertainable, but will be determined during
 24 this action.

25 40. Plaintiff alleges, on information and belief, that Defendant has derived,
 26 received, and will continue to derive and receive from the aforesaid acts of
 27 infringement, gains, profits, and advantages in an amount not yet ascertainable, but
 28 will be determined during this action.

41. Defendant acted intentionally and/or willfully in infringing upon the SUNENERGY1 mark, knowing that the SUNENERGY1 mark belonged to Plaintiff and that Defendant was not authorized to use the SUNENERGY1 mark.

COUNT III

43. Plaintiff re-alleges and incorporates by this reference each and every allegation in paragraphs 1 through 42 as though set forth fully herein.

49. Pursuant to California Business & Professions Code section 14250, Plaintiff is entitled to injunctive relief and damages in the amount of three times Defendant's profits and three times all damages suffered by Plaintiff by reason of Defendant's manufacture, use, display, or sale.

TRIAL BY JURY

50. Pursuant to the seventh amendment to the Constitution of the United States of America, Plaintiff is entitled to, and demands, a trial by jury.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff hereby respectfully prays this Court grant it the following relief:

1. Adjudge that Defendant has infringed Plaintiff's SUNENERGY1 trademark in violation of Plaintiff's rights under 15 U.S.C. § 1114, common law, and/or California law;
2. Adjudge that Defendant has competed unfairly with Plaintiff in violation of 15 U.S.C. § 1125(a), common law, and/or California law;
3. Award Defendant's profits and Plaintiff's damages for Defendant's illegal acts under 15 U.S.C. § 1117, trebled, in an amount to be proven at trial;
4. Issue an injunction prohibiting Defendant and its agents, servants, employees, and representatives and all persons in active concert and participation with it, during the pendency of this action and permanently thereafter, from: engaging or continuing to engage in the infringing, unlawful, unfair, or fraudulent business acts or practices described herein, including the marketing, sale, distribution, and/or other dealing in any services under any mark that is confusingly similar to the SUNENERGY1 mark; using without permission any mark or other intellectual property right of Plaintiff; acting to infringe the SUNENERGY1 mark; falsely designating the origin of any service to be from Plaintiff; engaging in

1 unfair competition with Plaintiff; or acting in any other manner to
2 derogate Plaintiff's intellectual property rights;

3 5. Issue an Order requiring that Defendant provide complete accountings and
4 for equitable relief, including that Defendant disgorge and return or pay
5 Plaintiff its ill-gotten gains obtained from the illegal transactions entered
6 into and/or pay restitution;

7 6. Issue an Order that an asset freeze or constructive trust be imposed over
8 all monies and profits in Defendant's possession which rightfully belong
9 to Plaintiff;

10 7. Pursuant to 15 U.S.C. § 1118, issue an Order requiring that Defendant and
11 all others acting under Defendant's authority, at their cost, be required to
12 deliver up to Plaintiff for destruction all products, accessories, labels,
13 signs, prints, packages, wrappers, marketing materials, and other material
14 in their possession, custody, or control bearing any mark that is
15 confusingly similar to the SUNENERGY1 mark;

16 8. Award treble damages and punitive damages;

17 9. Award Plaintiff's reasonable attorneys' fees;

18 10. Award all costs of suit;

19 11. Award prejudgment interest and post-judgment interest in the maximum
20 amount allowed under the law; and

21 12. Award such other and further relief as the Court may deem just and
22 equitable.

23 Dated: April 8, 2022

NELSON MULLINS RILEY &
SCARBOROUGH LLP

25 By: /s/ Lauren A. Deeb
26 Lauren A. Deeb

27 Attorneys for Plaintiff
28 SUNENERGY1, LLC

Exhibit A

United States of America

United States Patent and Trademark Office



Reg. No. 4,241,915

Registered Nov. 13, 2012

Int. Cls.: 37 and 42

SERVICE MARK

PRINCIPAL REGISTER

SUNENERGY1, LLC (NORTH CAROLINA LIMITED LIABILITY COMPANY)
192 RACEWAY DRIVE
MOORESVILLE, NC 28117

FOR: CONSTRUCTION, INSTALLATION AND MAINTENANCE OF SOLAR PV SYSTEMS;
INSTALLATION AND MAINTENANCE OF LED LIGHTING SYSTEMS; INSTALLATION
OF ROOFING SYSTEMS, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 10-0-2009; IN COMMERCE 1-14-2010.

FOR: DESIGN OF SOLAR PV SYSTEMS; DESIGN OF LED LIGHTING SYSTEMS, IN CLASS
42 (U.S. CLS. 100 AND 101).

FIRST USE 10-0-2009; IN COMMERCE 1-14-2010.

THE MARK CONSISTS OF AN ILLUSTRATION OF THE SUN AND CLOUDLESS SKY IN
THE COLORS BLUE AND ORANGE ABOVE THE STYLIZED WORDING "SUNENERGY1".
THE WORD "SUN" AND THE NUMBER "1" FEATURED IN THE COLOR BLUE AND THE
WORD "ENERGY" FEATURED IN THE COLOR ORANGE.

THE COLOR(S) BLUE AND ORANGE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 85-590,100, FILED 4-5-2012.

SUZANNE BLANE, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office

Exhibit B



Craig N. Killen
Registered Patent Attorney Admitted in SC
and NC
T: (704) 417-3127 F: (803) 255-9103
craig.killen@nelsonmullins.com

NELSON MULLINS RILEY & SCARBOROUGH LLP
ATTORNEYS AND COUNSELORS AT LAW

301 South College Street / 23rd Floor
Charlotte, NC 28202-6041
T: 704.417.3000 F: 704.377.4814
nelsonmullins.com

December 21, 2021

Via Federal Express

President
Sun Energy Construction
9037 Arrow Route Suite 100
Rancho Cucamonga, CA 91730

Re: SUNENERGY1 – Trademark Infringement

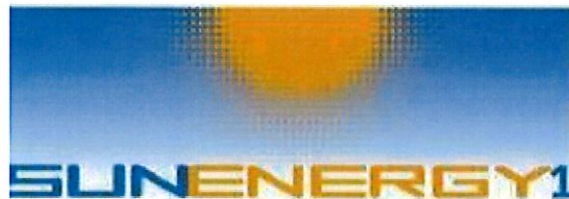
Dear Sir or Madam:

Our client, SunEnergy1, LLC, is the owner of registered and common law rights in the mark SUNENERGY1. For example, our client owns U.S. Reg. No. 4,241,915 (“the ‘915 Registration”) directed to a form of the mark. As you can see from the copy of the ‘915 Registration attached hereto, it *inter alia* recites services of “construction, installation and maintenance of solar PV systems.” As described in more detail below, it has come to our attention that Sun Energy Construction (SEC) is using the mark for services identical, or at least closely related, to those offered by our client.

In particular, SEC is using a mark that is confusingly similar to our client’s mark on at least the homepage of the website <https://www.sunenergyco.com/home> --

The logo for SUNENERGY, with 'SUN' in orange and 'ENERGY' in blue, both in a bold, sans-serif font.

The registered version of our client’s mark is:

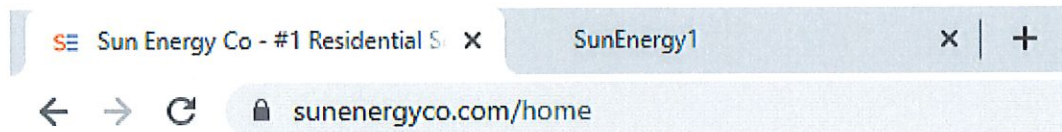


CALIFORNIA | COLORADO | DISTRICT OF COLUMBIA | FLORIDA | GEORGIA | MARYLAND | MASSACHUSETTS | NEW YORK
NORTH CAROLINA | SOUTH CAROLINA | TENNESSEE | WEST VIRGINIA

President, Sun Energy Construction
December 21, 2021
Page 2

The similarities are apparent. Both marks prominently feature SUNENERGY as one word. The colors are essentially the same, just reversed. Both marks feature a vertical element which is the numeral "1" or the like.

In fact, the website tab of your homepage even uses the number one after "Sun Energy," further compounding the damage to our client's trademark rights. Below is a side-by-side screen shot showing the tab of your homepage and that of our client:



SEC's use of the mark is likely to cause confusion or mistake, or is likely to deceive the public, in violation of 15 U.S.C. §§ 1114 and 1125(a), and in violation of state trademark law.

Therefore, we demand that you immediately and permanently cease all use of any mark that is confusingly similar to SUNENERGY1 as discussed above, including:

- 1) On any website controlled by you or otherwise used to advertise SEC's business;
- 2) In connection with any other advertising of the services, including on social media (e.g., Facebook);
- 3) At your business location; and
- 4) You must transition to an alternative mark which is not merely a colorable imitation of SUNENERGY1. A minor variation of the mark is not acceptable.

Please confirm by **January 21, 2022** that the above actions have been taken.

This letter shall not be deemed to be a waiver of any rights or remedies that our client may have, all of which are expressly reserved.

Very truly yours,

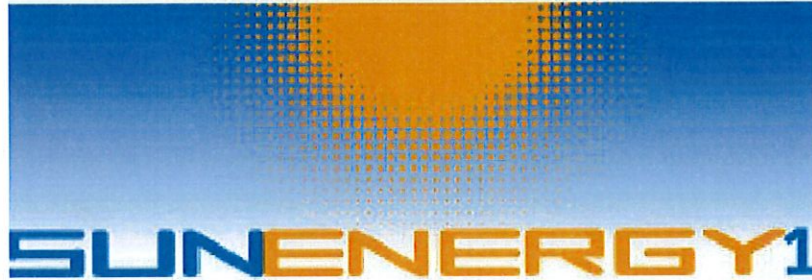
A handwritten signature in black ink that reads "Craig N. Killen". The signature is written in a cursive, flowing style.

Craig N. Killen

CNK:nd
Enclosure

United States of America

United States Patent and Trademark Office



Reg. No. 4,241,915

Registered Nov. 13, 2012

Int. Cls.: 37 and 42

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FIRST USE 10-0-2009; IN COMMERCE 1-14-2010.

FOR: DESIGN OF SOLAR PV SYSTEMS; DESIGN OF LED LIGHTING SYSTEMS, IN CLASS
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THE COLORS BLUE AND ORANGE ABOVE THE STYLIZED WORDING "SUNENERGY1".
THE WORD "SUN" AND THE NUMBER "1" FEATURED IN THE COLOR BLUE AND THE
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SER. NO. 85-590,100, FILED 4-5-2012.

SUZANNE BLANE, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office

Exhibit C

Dear Customer,

The following is the proof-of-delivery for tracking number: 287921712437

Delivery Information:

Status:	Delivered	Delivered To:	Receptionist/Front Desk
Signed for by:	G.JENNIFER	Delivery Location:	
Service type:	FedEx Priority Overnight		
Special Handling:	Deliver Weekday		RANCHO CUCAMONGA, CA,
		Delivery date:	Dec 22, 2021 15:36

Shipping Information:

Tracking number:	287921712437	Ship Date:	Dec 21, 2021
		Weight:	0.5 LB/0.23 KG
Recipient:		Shipper:	
RANCHO CUCAMONGA, CA, US,		Winston-Salem, NC, US,	

Reference 054943.01501-NDIAMOND-

Signature image is available. In order to view image and detailed information, the shipper or payor account number of the shipment must be provided.

Thank you for choosing FedEx